



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

[Handwritten signature]

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,889	12/20/2001	Jae Yoon Jeong	0630-1386P	2124

2292 7590 09/13/2004

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

SONG, JASMINE

ART UNIT PAPER NUMBER

2188

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/022,889	Applicant(s) JEONG, JAE YOON	
	Examiner Jasmine Song	Art Unit 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed on 08/12/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7,9-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7,9-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2188

Detailed Action

1. This office action is in response to Amendment filed on 08/12/2004, claims 1-2, 8 and 17 are canceled. Claims 3-7,9-16 and 18-20 are therefore still pending. In view of applicant's response, the finality of the last office action is withdrawn. New grounds of rejection are provided below.

Claim Objections

2. Claim 4 is objected to because of the following informalities: in claim 4, lines 2-3, "of which the" should be changed to --whose--. Appropriate correction is required.

Drawings

3. The drawing Fig.6 is objected to because: In Fig.6, step S604 determines if copy control code set as "restricted copy" or "a single copy", if yes, goes to step S605 and to S606, if no (it means copy control code set as "no copy"), goes to S607 to S608 and S609. S608 to S609 perform the same function as step S605 to S606, the control code for the restricted copy and no copy are different, therefore, it is not clear how to accomplish the same steps (S605-S606 same as S608-609) as shown in Fig.6 when the control code is different.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

Art Unit: 2188

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112, first paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 3,7 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the page 9 of specification, lines 5-13, the applicant explains **the copy control code of the contents stored in the first storage medium is increased by**

Art Unit: 2188

one time when the copy control code is set as restricted copy or no copy, but the claim language in claims 3,7 and 12 claim increasing by **one the possible number of copies of the contents**, this limitation is not enabled in the specification.

Claim Rejections - 35 USC § 112, second paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-4,7,10,12,19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 3, 7 and 12, the language "the copy control code of the contents is converted by increasing by one the possible number of copies of the contents if the copy control code is determined to indicate a restricted number of copies" is not clear or distinct. This language is not defined in either the actual claim language or the specification. It is not clear that how to accomplish increasing one to the possible number of copies since the copy control code is determined to indicated **a restricted number of copies** (for example: if the copy control code is determined to indicate a restricted number of copies 5, 5 itself is a restricted number, therefore, it can not be increased by one as claimed). Further, the language "increasing by one the possible number of copies of the contents" is not clear because there is no counter for storing possible number of copies of the contents, therefore, it is not clear how to perform the step "increasing by one the possible number of copies of the contents". Also, it is not clear how does the system works by increasing by one to

Art Unit: 2188

the possible number of copies. In claims 4,10 and 19, it is not clear how to change "no copy" to "a single copy" since "no copy" means copy is not possible. It is not possible from either the specification or the claims to determine the scope of this language or to determine the metes and bounds of the claims.

Due to the ambiguities and confusion in claims 3-4, 7,10,12 and 19 as cited above, no art has been applied thereto, see *In re Steele*, 49 CCPA 1295, 305 F. 2d 859, 134 USPQ 292 (1962) and *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). The examiner will not speculate as to the intended meaning.

Claims 5-6,8-9,11,13-18 and 20 are dependent on claims 3, 7,12 and therefore have the same deficiencies.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yuasa et al	6636953 B2
-------------	------------

Itoh et al	6700989 B1
------------	------------

9. Applicant's amendment (filed on 03/05/2004) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. When responding to the office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. See 37 C.F.R. 1.111 (c).

11. When responding to the office action, Applicants are advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist examiner to locate the appropriate paragraphs.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine Song whose telephone number is 703-305-7701. The examiner can normally be reached on 8:00-5:30 (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on 703-306-2903. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

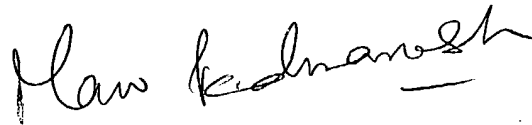
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Jasmine Song



Patent Examiner

September 10, 2004



Mano Padmanabhan

**MANO PADMANABHAN
SUPERVISORY PATENT EXAMINER**

Supervisory Patent Examiner

Technology Center 2100